

REMARKS

By this Amendment, Claims 13-18 and 22 are amended. Figures 1 and 2 are amended to add the caption "PRIOR ART," as suggested in the Official Action. Reconsideration of the August 1, 2003, Official Action is respectfully requested in view of the following remarks.

1. Restriction Requirement

Claims 13-22 stand withdrawn from consideration as being directed to non-elected subject matter. Elected Claim 1 is directed to an apparatus for retaining an electrode plate in a plasma reaction chamber (i.e., to a product). Independent Claim 13 has been amended to recite a method of assembling an apparatus for retaining an electrode plate in a plasma reaction chamber, and to include all of the features recited in elected Claim 1. Dependent Claims 14-17 have been amended to be consistent with amended Claim 13. Independent Claim 18 has been amended to depend from Claim 1. Accordingly, amended Claim 18 includes all of the features recited in Claim 1. Claim 22 has been amended to be consistent with amended Claim 18.

MPEP § 821.04 states that "if applicant elects claims directed to the product, and a product claim is subsequently found allowable, *withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined*" (emphasis added). Accordingly, once Claim 1 is determined to be allowable, Claims 13 and 18 (and all claims dependent therefrom) must be rejoined with the elected subject matter.

2. Rejection of Claims 1-3, 6 and 8-10 Under 35 U.S.C. § 102(e)

Claims 1-3, 6 and 8-10 stand rejected under 35 U.S.C. § 102(e) over JP 2001-085398 ("JP '398"). The reasons for the rejection are stated at pages 4-5 of the Official Action. The rejection is respectfully traversed.

JP '398 was published on March 30, 2001. The present application has a U.S. filing date of December 18, 2001. Accordingly, JP '398 qualifies as *prima facie* prior art under 35 U.S.C. § 102(a) against the present application.

However, as discussed at MPEP § 715.07, page 700-232 (Feb. 2003), a prior invention can be shown by a Rule 131 Declaration that provides evidence of "*reduction to practice* of the invention prior to the effective date of the reference" (emphasis added). As further stated at the same page, "[i]n general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose."

The effective date of JP '398 is March 30, 2001. In order to establish an earlier invention date than March 30, 2001, and thus eliminate JP '398 as a reference against the present application, submitted herewith is a Declaration Under 37 C.F.R. § 1.131 By Rajinder Dhindsa and Eric Lenz ("Declaration"), the two co-inventors of the claimed invention. The Declaration provides evidence that the subject matter recited in independent Claim 1 was reduced to practice prior to March 30, 2001.

Accordingly, because Applicants have established reduction to practice of the claimed invention prior to March 30, 2001, JP '398 does not qualify as a reference under 35 U.S.C. § 102(a) against Claim 1 and the claims dependent therefrom.

3. Rejections Under 35 U.S.C. § 103(a)

(1) Claims 4 and 5 stand rejected under 35 U.S.C. § 103(a) over JP '398 in view of U.S. Patent No. 6,074,488 to Roderick et al. ("Roderick") for the reasons stated at page 6 of the Official Action; (2) Claims 7 and 12 stand rejected under 35 U.S.C. § 103(a) over JP '398 for the reasons stated at pages 6-7 of the Official Action; and (3) Claim 11 stands rejected under 35 U.S.C. § 103(a) over JP '398 in view of U.S. Patent No. 5,074,456 to Degner et al. ("Degner") for the reasons stated at page 7 of the Official Action. As each of Claims 4, 5, 7, 11 and 12 depends from Claim 1, and JP '398 does not qualify as a reference under 35 U.S.C. §102(a) against Claim 1 (and thus also does not qualify under 35 U.S.C. §103), the rejections of Claims 4, 5, 7, 11 and 12 under 35 U.S.C. §103(a) are moot.

For the foregoing reasons, withdrawal of the rejections, rejoinder of the withdrawn claimed subject matter, and prompt allowance of the application are respectfully requested.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: November 3, 2003

By: 
Edward A. Brown
Registration No. 35,033

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620